

**REMARKS**

The Final Office Action mailed July 11, 2005, has been received and reviewed. Claims 2 through 5, 7 through 25, 35 and 36 are currently pending in the application. Claims 5, 7 through 25, 35 and 36 stand rejected. Applicant proposes to amend no claims herein, and respectfully requests reconsideration of the application claims as listed herein.

**35 U.S.C. § 112 Claim Rejections**

Claims 2 through 5, 7 through 25, 35 and 36 stand rejected under 35 U.S.C. § 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Applicant respectfully traverses this rejection, as hereinafter set forth.

The Office Action states:

Support could not be found for having *a memory in the RIC* that includes means for *inputting the unique identifier into the memory at a point of sale*. (Office Action, p. 2; emphasis added).

Applicants respectfully disagree that the amendments to the claims made in the previous amendments to the claims in the prior Response to the Office Action do not comply with the written description requirement of 35 U.S.C. §112, first paragraph.

M.P.E.P. § 2173.05(e) provides:

There is no requirement that the words in [a] claim must match those used in [a] specification disclosure. Applicants are given a great deal of latitude in how they choose to define their invention so long as the terms and phrases used define the invention with a reasonable degree of clarity and precision.

Furthermore, in *Staehelin v. Secher*, the Board held that “[s]atisfaction of the ‘written description’ requirement does not require an *haec verba* antecedence in the originally filed application.” (24 USPQ2d 1513, 1519 (B.P.A.I. 1992)). In *Ex parte Parks*, the Board further elaborated:

Adequate description under the first paragraph of 35 U.S.C. 112 does not require *literal*

support for the claimed invention. . . . Rather, it is sufficient if the [] disclosure would have conveyed to one having ordinary skill in the art that an appellant had possession of the concept of what is claimed. (30 USPQ2d 1234, 1236 (B.P.A.I. 1994).

Applicants respectfully direct the Examiner's attention to several passages within Applicants' application as originally filed, which provide an adequate basis for the language in question. Specifically, Applicants' as-filed application includes the following passages in support of the exemplary claim languages of "a memory in the RIC" and "inputting the unique identifier into the memory at a point of sale", specifically:

Figure 4 illustrates the step T100 describing "Manufacture Device With Anti-Theft Assy" followed by step T101 describing "Input Specific Data At Point Of Sale."

Figure 2 illustrates an RIC including a Memory 95 and I/O 97 coupled to an Input Device 11.

Page 12, Last Paragraph recites and describes, "At the retail level, for example, data relating to the electronic apparatus may be input via the input device 11 (T101) and is stored in the memory 95 via the I/O port 97. The input data should include at least a unique product identifier such as a serial number. Additional information such as authorized user information, purchase information, reset authorization security codes and the like may also be entered at this time."

Page 9, First Whole Paragraph recites and describes, "The input device may be, for example, a keypad or other input device provided on the electronic device itself. Alternatively, the input device may be an input terminal or connector which permits the device to receive input signals from another device such as a personal computer. Utilizing an input connector as the input device may be preferable in most consumer electronic devices to help minimize the size of the product and to reduce manufacturing costs."

Page 8, Last Paragraph recites and describes, "The RIC unit 9 preferably includes . . . a memory device 95, and a digital serial I/O port 97."

Page 8, First Paragraph recites and describes, "including unique identifying information such as a serial number. Other information specific to the property, such as

purchase date and location, . . . could be entered as well if such information was previously stored in memory of the stolen property.”

Page 10, Second Paragraph recites and describes, “the microcontroller 93 can maintain the transistor 21 in the OFF state until an appropriate security code or other information . . . (such as purchase date, location, etc.) is entered by way of input device 11. The microcontroller compares the input date to stored data to verify the information . . .”

Page 14, Last Paragraph recites and describes, “The microcontroller 93 compares the input information with the information stored in the memory unit 95.”

From Applicants’ written description in Applicants’ as-filed patent application, it is apparent that Applicants, at the time of invention, were in possession of the exemplary concept of “the *RIC unit, including: . . . a memory configured to receive and store therein a unique identifier of a specific one of the electronic apparatus; [and] means for inputting the unique identifier into the memory at a point of sale*” as illustrated by the various claims at issue.

Accordingly, it is respectfully submitted that claims 2 through 5, 7 through 25, 35 and 36 comply with the written description requirement of 35 U.S.C. § 112, first paragraph, and Applicants respectfully request that the 35 U.S.C. § 112, first paragraph, rejection of these claims be withdrawn.

### **35 U.S.C. § 103(a) Obviousness Rejections**

Obviousness Rejection Based on U.S. Patent No. 5,748,084 to Isikoff, U.S. Patent No. 6,664,888 to Bishop and either U.S. Patent No. 6,094,146 to Sharpe or U.S. Patent No. 5,850,445 to Chan

Claims 2 through 5, 7 through 15, 19, 20, 35 and 36 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Isikoff (U.S. Patent No. 5,748,084), Bishop (U.S. Patent No. 6,664,888) and either Sharpe (U.S. Patent No. 6,094,146) or Chan (U.S. Patent No. 5,850,445). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references

themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 2 through 5, 7 through 15, 19, 20, 35 and 36 are improper because elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Applicants submit that any proposed combination of the Isikoff reference in view of the Bishop reference and further in view of either the Sharpe reference or the Chan reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention of independent claim 35, as well as claims 2 through 5 depending therefrom because, at the very least, the cited prior art does not teach or suggest all the claim limitations of the presently claimed invention as set forth hereinabove. Applicants submit that any proposed combination of the Isokoff reference, the Bishop reference and either the Sharpe reference or the Chan reference does not teach or suggest the claim limitations calling for:

35. An anti-theft device cooperatively operable with normal utilization circuits within an electronic apparatus, comprising:

a remote intelligent communication (RIC) unit configured for ***enablingly coupling with the normal utilization circuits***, the RIC unit, including:

a control circuit including:

a memory configured to receive and store therein a unique identifier of a specific one of the electronic apparatus;

***means for inputting the unique identifier into the memory at a point of sale***; and

a transceiver configured to at least receive a signal; and

a shut-off unit configured for ***entering a shut-off state*** and disabling operative power via a shut-off signal to the normal utilization

circuits *in response to receipt of the signal* via the transceiver of a shut-off command *designating the unique identifier* stored in the RIC unit. (Emphasis added.)

The Isikoff reference teaches or suggests “object tracking, communication, and management system for a laptop computer or similar device, wherein a beacon or transceiver in the computer implements file integrity or device recovery steps.” (Isikoff Abstract).

The Bishop reference teaches or suggests an “apparatus and method designed for use with a vehicle that remotely activates an audio warning device prior to disabling the ability for the driver to start the vehicle.” (Bishop Abstract).

Regarding the newly cited Sharpe and Chan references, the Office Action states: both Sharpe and Chan teach programming security identity codes into electronic communication devices at the point of sale.” (Office Action, p. 4; emphasis added). Applicants respectfully direct the Examiner’s attention to the specific teachings and suggestions of the Sharpe and Chan references.

Regarding the specific teachings and suggestion of the Sharpe reference, the Sharpe reference is drawn to a method for transmitting messages in a communication system. The Office Action cites to the “Receiver Identity Code” RIC which is a code that is programmed into devices, for example pagers, to allow the device to sort through all of the messages that are broadcast and then compare the addresses in the broadcast messages with the stored RIC. When a match with a message addressee corresponds to the stored RIC of the device, then the device displays the content of that message for the user to perceive. In an unprogrammed state, the device as taught or suggested in the Sharpe reference is not disabled but rather ignores the broadcast messages.

Similarly regarding the specific teachings and suggestions of the Chan reference, the Chan reference is drawn to activation of an authentication process in a device. Specifically the Chan reference teaches or suggests, “It is preferable that an MS 102 be programmed (or re-programmed) with sensitive authentication information at the point of sale of the MS 102. This will enable the MS to be quickly activated with the authentication feature.” (Col. 7, lines 63-67). Similarly, the Chan device in an unprogrammed state, is not disabled nor is the programming

information (e.g., unique identifier) directly related to the enablement and disablement of the normal utilization circuits of the device, as claimed by Applicants.

Applicants respectfully assert that none of the cited prior art references, either individually or in any proper combination, teach or suggest Applicants' invention as claimed in independent claim 35, namely, "An anti-theft device cooperatively operable with normal utilization circuits within an electronic apparatus, comprising: a remote intelligent communication (RIC) unit configured for *enablingly coupling with the normal utilization circuits*, the RIC unit, including: a control circuit including: a memory configured to receive and store therein a unique identifier of a specific one of the electronic apparatus; *means for inputting the unique identifier into the memory at a point of sale*; and a transceiver configured to at least receive a signal; and a shut-off unit configured for *entering a shut-off state and disabling operative power via a shut-off signal to the normal utilization circuits in response to receipt of the signal* via the transceiver of a shut-off command *designating the unique identifier* stored in the RIC unit." (Emphasis added.)

Applicants submit that any rejection of the presently claimed invention based upon any combination of the Isikoff reference in view of the Bishop reference and further in view of either the Sharpe reference or the Chan reference under 35 U.S.C. § 103 would be a hindsight reconstruction of the presently claimed invention based solely upon the Applicants' disclosure. Such a rejection is neither within the ambit nor the purview of 35 U.S.C. § 103 and, clearly, improper.

As evidence that any rejection of the presently claimed invention based upon the Isikoff reference in view of the Bishop reference and further in view of either the Sharpe reference or the Chan reference is a hindsight reconstruction of the presently claimed invention, Applicants submit that since (i) the Isikoff reference is directed to locally tracking a stolen computer broadcasting a beacon signal; (ii) the Bishop reference is directed to notification of the forthcoming disablement of a stolen automobile; (iii) the Sharpe reference is directed to supplying a pager with an address for comparatively identifying pertinent messages from a plethora of broadcast messages; and (iv) the Chan reference is directed to providing a portion of the authentication code for augmenting security in a network, there is no suggestion or teaching

whatsoever in the cited prior art for any modification thereof to yield the presently claimed invention but, solely, Applicants' own disclosure.

Therefore, Applicants' claim 35 and claims 2-5 depending therefrom are clearly allowable over the cited prior art of the Isikoff reference in view of the Bishop reference and further in view of either the Sharpe reference or the Chan reference

Regarding independent claim 36 and claims 7-10 depending therefrom, Applicants submit that independent claim 36 includes similar limitations in method form. Applicants sustain the above-proffered arguments as to the lack of teaching and suggestion in the cited prior art references. Applicants submit that any proposed combination of the Isikoff reference in view of the Bishop reference and further in view of either the Sharpe reference or the Chan reference, does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding the presently claimed invention of independent claim 36, as well as claims 7 through 10 depending therefrom because, at the very least, the cited prior art does not teach or suggest all the claim limitations of the presently claimed invention as set forth hereinabove. Applicants submit that any proposed combination of the Isokoff reference, the Bishop reference and either the Sharpe reference or the Chan reference, does not teach or suggest the claim limitations calling for:

36. A method of operating an anti-theft device cooperatively operable with normal utilization circuits within an electronic apparatus, the anti-theft device including a remote intelligent communication (RIC) unit and a shut-off unit, the method comprising:
- coupling the anti-theft device to normal utilization circuits within an electronic apparatus;
  - inputting into a memory in the anti-theft device at a point of sale a unique identifier of a specific one of the electronic apparatus;***
  - evaluating a received signal at the anti-theft device; and
  - entering a shut-off state and disabling operative power via a shut-off signal to the normal utilization circuits in response to receipt of the signal having therein a shut-off command designating the unique identifier stored in the memory. (Emphasis added.)

Therefore, Applicants' claim 36 and claims 7-10 depending therefrom are clearly allowable over the cited prior art of the Isikoff reference in view of the Bishop reference and

further in view of either the Sharpe reference or the Chan reference

Regarding claims 11-15, 19 and 20 (and presumably claims 21-25 not otherwise rejected in the Office Action), Applicants submit that any proposed combination of the Isikoff reference in view of the Bishop reference and further in view of either the Sharpe reference or Chan reference, does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding independent claim 11 from which claims 12-15 and 19-25 at least indirectly depend because, at the very least, the cited prior art does not teach or suggest all the claim limitations of the presently claimed invention as set forth hereinabove. Applicants sustain the above-proffered arguments as to the lack of teaching and suggestion in the cited prior art references. Applicants submit that any proposed combination of the Isokoff reference and the Bishop reference does not teach or suggest the claim limitations calling for:

11. An anti-theft device for shutting off an operable electronic apparatus subsequent to the electronic apparatus being stolen from its owner, the anti-theft device comprising:

a communication unit incorporated within the casing of the electronic apparatus and comprising:

*a memory configured to receive and store therein unique identifier stored data of a specific one of the electronic apparatus;*

*means for inputting the unique identifier stored data into the memory at a point of sale;*

a receiver for receiving a signal transmitted from an interrogator, and

a control circuit that is coupled to the receiver for determining whether the received signal designates the unique identifier stored data of the anti-theft device and, if so, for determining whether the signal includes an electronic apparatus shut-off command generated by the interrogator in response to a notification from the owner that the electronic apparatus has been stolen, and, if so, for producing a shut-off signal, and a power blocking circuit responsive to the shut-off signal for placing the electronic apparatus in a shut-off state by blocking the flow of electricity from a power source of the electronic apparatus to normal utilization circuitry of the electronic apparatus. (Emphasis added.)

Therefore, Applicants' claims 11-15 and 19-25 are clearly allowable over the cited prior art of the Isikoff reference in view of the Bishop reference and further in view of either the Sharpe reference or Chan reference. Accordingly, Applicants respectfully request the rejections of claims 11-15 and 19-25 be withdrawn.



Obviousness Rejection Based on U.S. Patent No. 5,748,084 to Isikoff, U.S. Patent No. 6,664,888 to Bishop, U.S. Patent No. 6,094,146 to Sharpe and U.S. Patent No. 5,850,445 to Chan as discussed above regarding claims 11 and 15 and further in view of U.S. Patent No. 5,515,419 to Sheffer

Claims 16 and 17 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Isikoff (U.S. Patent No. 5,748,084), Bishop (U.S. Patent No. 6,664,888), Sharpe (U.S. Patent No. 6,094,146) or Chan (U.S. Patent No. 5,850,445) as discussed above regarding claims 11 and 15 and further in view of Sheffer (U.S. Patent No. 5,515,419). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 16 and 17 are improper because elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding claims 16 and 17 depending at least indirectly from independent claim 11, Applicants submit that any proposed combination of the Isikoff reference in view of the Bishop reference and further in view of either the Sharpe reference or Chan reference and yet further in view of the Sheffer reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding independent claim 11 from which claims 16 and 17 at least indirectly depend because, at the very least, the cited prior art does not teach or suggest all the claim limitations of the presently claimed invention as set forth hereinabove. Applicants sustain

the above-proffered arguments regarding the lack of teaching and suggestion in the cited prior art references and submit that any proposed combination of the Isokoff reference, the Bishop reference, either the Sharpe reference or Chan reference, and the Sheffere reference does not teach or suggest the claim limitations calling for:

11. An anti-theft device for shutting off an operable electronic apparatus subsequent to the electronic apparatus being stolen from its owner, the anti-theft device comprising:

a communication unit incorporated within the casing of the electronic apparatus and comprising:

*a memory configured to receive and store therein unique identifier stored data of a specific one of the electronic apparatus;*

*means for inputting the unique identifier stored data into the memory at a point of sale;*

a receiver for receiving a signal transmitted from an interrogator, and

a control circuit that is coupled to the receiver for determining whether the received signal designates the unique identifier stored data of the anti-theft device and, if so, for determining whether the signal includes an electronic apparatus shut-off command generated by the interrogator in response to a notification from the owner that the electronic apparatus has been stolen, and, if so, for producing a shut-off signal, and a power blocking circuit responsive to the shut-off signal for placing the electronic apparatus in a shut-off state by blocking the flow of electricity from a power source of the electronic apparatus to normal utilization circuitry of the electronic apparatus. (Emphasis added.)

Therefore, Applicants respectfully request the rejection of claims 16 and 17 be withdrawn.

Obviousness Rejection Based on U.S. Patent No. 5,748,084 to Isikoff, U.S. Patent No. 6,664,888 to Bishop and either U.S. Patent No. 6,094,146 to Sharpe or U.S. Patent No. 5,850,445 to Chan as discussed above regarding claim 11 and further in view of U.S. Patent No. 5,406,261 to Glenn

Claim 18 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Isikoff (U.S. Patent No. 5,748,084), Bishop (U.S. Patent No. 6,664,888), Sharpe (U.S. Patent No. 6,094,146) and Chan (U.S. Patent No. 5,850,445) as discussed above regarding claim 11 and further in view of Glenn (U.S. Patent No. 5,406,261). Applicant respectfully traverses this rejection, as hereinafter set forth.

M.P.E.P. 706.02(j) sets forth the standard for a Section 103(a) rejection:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, **the prior art reference (or references when combined) must teach or suggest all the claim limitations.** The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). (Emphasis added).

The 35 U.S.C. § 103(a) obviousness rejections of claims 18 is improper because elements for a *prima facie* case of obviousness are not met. Specifically, the rejection fails to meet the criterion that the prior art reference must teach or suggest all the claims limitations.

Regarding claim 18 depending from independent claim 11, Applicants submit that any proposed combination of the Isikoff reference in view of the Bishop reference and further in view of the Sharpe reference and/or the Chan reference and yet further in view of the Glenn reference does not and cannot establish a *prima facie* case of obviousness under 35 U.S.C. § 103 regarding presently amended independent claim 11 from which claim 18 depends because, at the very least, the cited prior art does not teach or suggest all the claim limitations of the presently claimed invention as set forth hereinabove. Applicants sustain the above-proffered arguments regarding the lack of teaching or suggestion in the prior art and submit that any proposed combination of the Isokoff reference, the Bishop reference, either the Sharpe reference or Chan reference, and the Glenn reference does not teach or suggest the claim limitations calling for:

11. An anti-theft device for shutting off an operable electronic apparatus subsequent to the electronic apparatus being stolen from its owner, the anti-theft device comprising:

a communication unit incorporated within the casing of the electronic apparatus and comprising:

***a memory configured to receive and store therein unique identifier stored data of a specific one of the electronic apparatus;***

***means for inputting the unique identifier stored data into the memory at a point of sale;***

a receiver for receiving a signal transmitted from an interrogator, and  
a control circuit that is coupled to the receiver for determining whether the

received signal designates the unique identifier stored data of the anti-theft device and, if so, for determining whether the signal includes an electronic apparatus shut-off command generated by the interrogator in response to a notification from the owner that the electronic apparatus has been stolen, and, if so, for producing a shut-off signal, and a power blocking circuit responsive to the shut-off signal for placing the electronic apparatus in a shut-off state by blocking the flow of electricity from a power source of the electronic apparatus to normal utilization circuitry of the electronic apparatus. (Emphasis added.)

Therefore, Applicants respectfully request the rejection of claim 18 be withdrawn.

**ENTRY OF AMENDMENTS**

Applicants propose to amend no claims herein. The proposed arguments and previous amendments are supported by the as-filed specification and drawings and do not add any new matter to the application. Further, Applicants' remarks do not raise new issues or require a further search. Finally, if the Examiner determines that the remarks do not place the application in condition for allowance, entry is respectfully requested upon filing of a Notice of Appeal herein.

**CONCLUSION**

Claims 2 through 5, 7 through 25, 35 and 36 are believed to be in condition for allowance, and an early notice thereof is respectfully solicited. Should the Examiner determine that additional issues remain which might be resolved by a telephone conference, he is respectfully invited to contact Applicant's undersigned attorney.

Respectfully submitted,



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